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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,557	08/18/2003	Li Ping Chen		4936

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WEI TE CHUNG
FOXCONN INTERNATIONAL, INC.
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EXAMINER

CHAN, KO HUNG

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,557

Applicant(s)

CHEN ET AL

Examiner

Korie H. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18-22 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Priority

Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) is acknowledged. However, the foreign application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 16-22 of this application. The claimed feature of the first and second sidewalls being outwardly deflectable relative to the bottom wall is not found in the foreign application.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18, line 2, "the fixing structure" is vague and indefinite as it is not clear which fixing structure applicant is referring to as there are a plurality of fixing structures. If applicant means all fixing structures, then the term should be plural. Claim 20 is vague and indefinite in that applicant has only mentioned that fixing holes on one side face in claim 16, and they received locating pins as recited in claim 16; however, in claim 20, recites the fixing tab has a through hole corresponding to the fixing hole of the storage device makes no sense since such "fixing hole" one side face is already in use. Applicant needs to set forth the other side face has fixing holes as well. Regarding claim 21, line 2, "form" should be corrected to "from".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 16, 18, 19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Root (US patent no. 3,182,807). Root disclose a mounting apparatus comprising: a storage device (consider the three parts 12 as one storage device) defining two opposite side faces (26 and 28) with a plurality of fixing holes (30); and a mounting bracket (50, figure 3) comprising: a bottom wall (38); opposite first and second side walls (42A and 44A) extending from two opposite side edges of the bottom wall, the storage device being seated upon the bottom wall with the two side faces respectively engaged with the corresponding side walls of the bracket; and a plurality of locating pins (48A-C on wall 42A) extending inwardly from the first side wall and received in the corresponding fixing holes, respectively; wherein the mounting bracket further includes a plurality of fixing structures (48A-C on the wall 44A) located oppositely far away from the first side wall and fixing the storage device relative to the bracket, wherein at least one of the first and second side walls is outwardly deflectable (Col. 2, lines 48-50) relative to the bottom wall. Regarding claim 18, Root discloses the fixing structure as being a through hole (see figure 6, the hole as a result of the punched out indent extends through the plane of the wall) in the second sidewall.

Regarding applicant's intended use language "for downward loading the storage device into the bracket", Root's device is capable of downward loading the storage

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device by for example tilt the potentiometer and sliding a first portion of the potentiometer into the pocket between 46 and bottom wall 38 and then deflect both walls to place the opposite portion of the potentiometer into the opposite pocket. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Root (US patent no. 3,182,807) in view of Dials et al (US patent no. 6,418,012). Root disclosed all the claimed features of applicant's invention except for a fixing tab with through hole extend from the bottom wall and being parallel and spaced from the second side wall. Dials teaches in a storage mounting apparatus having locating pins (312, figure 5B) for engaging fixing holes on one side of storage device and fixing tabs (314) with through hole (318) for receiving fastener therethrough wherein the fixing tabs extend from the bottom wall (308) for affixing smaller storage device. It would have

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been obvious to one of ordinary skilled in the art to have modify the mounting apparatus of Root by providing fixing tab with through hole to extend from the bottom wall for affixing smaller storage devices as taught by Dials. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed 5/25/2005 have been fully considered but they are not persuasive as discussed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Korie H. Chan
Primary Examiner
Art Unit 3632

khc
August 1, 2005